

Remarks:

In the Office Action, claims 6-8 were objected to as allegedly having informalities. Claims 1, 11, 13 and 14 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by Karpman, U.S. Patent No. 4,825,337. As discussed in the next paragraph, Applicants believe that claims 1-3 and 11-15 were rejected under 35 U.S.C. § 102(e), as allegedly anticipated by Koenen, U.S. Patent No. 6,349,035. Applicants note with appreciation that claims 6-8 were acknowledged to be allowable over the references of record if rewritten in independent form.

Applicants note that Section 4 of the Office Action recited that "claims 1-13 and 11-15" were rejected. However, because 1-13 and 11-15 overlap, because claims 4, 5, 9 and 10 are withdrawn, and because the Office Action recited that claims 6-8 were allowable over the references of record (except for depending from a rejected claim), Applicants believe that the recitation of "claims 1-13" was a typographical error, and that the Office Action was intended to recite "claims 1-3 and 11-15."

The above-described objections and rejections are addressed as follows:

1. GENERAL AMENDMENTS

The amendment of claims 2, 12 and 15 make them independent. Applicants note that the claims from which they depended have not been canceled, that this amendment does not narrow the claims, and that this amendment does not relate to patentability. This amendment was done to separate the prosecution of claims 2, 12 and 15 from their former independent claims, and to avoid the incorporation of amendments to their former independent claims.

New claims 16-20 have been added to the application. These claims recite previously recited elements, and should not require an additional search by the Examiner. No new matter has been added by these claims.

2. OBJECTIONS TO CLAIMS 6-8

Applicants have amended claim 6, making it independent, and thereby addressing the objection to claims 6-8. Applicants note that claim 1 has not been canceled, that this amendment does not narrow the claim, and that this amendment does not relate to patentability. Applicants respectfully request that the Examiner withdraw the objections to claims 6-8.

3. REJECTIONS OVER THE CITED ART

a. Rejection Under 35 U.S.C. § 102(e)

Claims 1-3 and 11-15 were rejected under 35 U.S.C. § 102(e), as allegedly anticipated by the Koenen patent, which issued on February 19, 2002, and was filed on September 29, 2000. The present application claims priority from provisional application Serial No. 60/271,273, which was filed on February 22, 2001.

To antedate the Koenen patent, and without consideration of whether the Koenen patent shows Applicants' invention, Applicants append to this Amendment Applicants' Declaration of Prior Invention Under 37 C.F.R. § 1.131. This declaration establishes invention of the subject matter of the rejected claims prior to the effective date of the Koenen patent.

Because Applicants have antedated the Koenen patent, Applicants respectfully request the Examiner withdraw the rejection of Claims 1-3 and 11-15 (and any other that might be applicable) under 35 U.S.C. § 102(e), as allegedly anticipated by the Koenen patent.

b. Rejection Under 35 U.S.C. § 102(b)

Claims 1, 11, 13 and 14 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by Karpman.

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- i. The Cited Art must Describe Every Element of Each Claims to Establish a *Prima Facie* Case of Anticipation

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"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See*, M.P.E.P. § 706.02, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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- ii. The Cited Art Fails to Describe Every Element of Each Claim, as Amended

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Claim 1 now recites "a first cold plate configured to absorb heat dissipated from the first and second heat sources", and "a first actuator configured to actuate the first cold plate into conforming thermal contact with the first and second heat sources." Similarly, claim 11 now recites "a cold plate configured to absorb heat dissipated from the first and second heat sources; and a means for actuating the cold plate into conforming thermal contact with the first and second heat sources." Claim 13 depends from claim 11, and incorporates its elements. Claim 14 now recites the step of "retractably actuating an actuator carrying a cold plate such that the cold plate is moved into conforming thermal contact with the first and second heat sources on the circuit board."

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Karpman fails to disclose a cold plate being (or configured to be) actuated into thermal contact with the heat sources. Thus, Karpman fails to describe every element of claims 1, 11, 13 and 14, as amended.

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iii. The Office Action Fails to Establish a *Prima Facie* Case of Anticipation

5 Because the cited art fails to describe every element of claims 1, 11, 13 and 14, Applicants have overcome the rejection under 35 U.S.C. § 102(b), with respect to the Karpman patent. Accordingly, the rejection of claims 1, 11, 13 and 14, under 37 U.S.C. § 102(b), is now improper, and Applicants respectfully request it be withdrawn.


10 4. CONCLUSION

In view of the foregoing, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

15 Respectfully submitted,

BASH et al.

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